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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/726,273
Filing Date: December 02, 2003
Appellant(s): CZAYKA ET AL.

Jonh J. Cunniff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 6, 2008 appealing from the Office action mailed December 6, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 2-4, 10-14 and 19-30.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,063,864	Mathur et al	5-2000
5,985,785	Lane et al	11-1999
4,327,145	Mitani et al	4-1982
3,429,950	Parker, Jr.	2-1969
3,300,544	Parker, Jr.	1-1967
401251791A	Japan	10-1989
54120675A	Japan	9-1979

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitani et al (US 4,327,145).

Mitani et al teach an easily handleable sheet molding compound (B-stage) comprising impregnated glass fibers with a resin composition comprising an unsaturated polyester, polymerizable monomer (such as styrene) and peroxide, and said composition is free from thickening agents such as magnesium oxide (abstract, col. 2, lines 14-45, col. 3, lines 5-13,and col. 4, lines 9-40).

With respect to an electron beam irradiation, it has no probative value in the instant invention since an invention in a product-by-process is a product, not a process. See ***In re Brown***, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and ***In re Thorpe***, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

With respect to "consisting essentially of ", the recitation of "consisting essentially of" alone cannot overcome the rejection based on the art reciting "comprising". See ***In re De Lajarte***, 337 F2d 870, 143 USPQ 256 (CCPA, 1964); When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of", applicant has the burden of showing the basic and novel characteristics of his composition – i.e. a showing that the introduction of these components would materially change characteristics of applicant's invention.

Thus, the instant invention lacks novelty.

Claims 19-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parker, Jr. (US 3,429,950).

Parker, Jr. teaches a partially cured, fusible, rubbery, putty-like, solid of an unsaturated polyester with styrene (B-staged prepreg) at col.3, lines 43-59 and in example 3. The use of filler in the production of said B-staged prepreg is also taught at col. 3, line 74 to col. 4, line 10. Also, addition of peroxide in said B-staged prepreg for the complete crosslinking (final application) is taught at col. 4, lines 10-21. With respect to claim 9, an invention in a product-by-process is a product, not a process. See ***In re Brown***, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and ***In re Thorpe***, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Thus, the invention lacks novelty.

Claims 19-26 are rejected under 35 U.S.C. 103(a) as obvious over Parker, Jr. (US 3,429,950) in view of Parker, Jr. (US 3,300,544), JP 54120675 A or JP 401251791 A.

Parker, Jr. (US '544) teaches that B-stage is a partially crosslinked at col. 2, lines 18-29, and abstracts of JPs teach the same. Parker, Jr. (US '544) is also an inventor for the primary reference, US'950.

Thus, the cited secondary references support the examiner's position in above anticipation rejection, or it would be obvious to one skilled in the art at the time of

invention to crosslink the unsaturated polyester of Parker, Jr. (US'950) with teaching of the secondary references since all teach B-stage polyester.

English translation of JP401251791A is enclosed. English translation of JP 54120675 A will be coming soon.

Claims 2-4, 10-14 and 19-30 are rejected under 35 U.S.C. 103(a) as obvious over Mitani et al (US 4,327,145) or Parker, Jr. (US 3,429,950) in view of Mathur et al (US 6,063,864), Lane et al (US 5,985,785) or JP 54120675 A.

Mitani et al and Parker, Jr. teach partially crosslinked B-stage polyesters.

The invention further recites irradiation with high-energy electrons over the heat polymerization (partial curing) of Mitani et al and Parker, Jr. However, use of an electron beam source in curing unsaturated polyester is well known as taught by Mathur et al (col. 2, line16-17 and col. 3, lines 40-45) and Lane et al (col. 8, lines 34-35). Both Mathur et al and Lane et al teach and equate various polymerization (or crosslinking) methods such as heat, UV radiation and electron beam. Furthermore, Lane et al teach that one can adjust dosage conditions at bottom of col. 8.

JP teaches the use of irradiation in parital curing (crosslinking) of polyester to B-stage in abstract.

It would have been obvious to one skilled in the art at the time of invention to utilize the electron beam source taught by Mathur et al, Lane et al or JP in Mitani et al or Parker, Jr. since irradiation with high energy electrons is well known in curing unsaturated polyester and since Mathur et al and Lane et al teach and equate various

polymerization (or crosslinking) methods such as heat, UV radiation and electron beam and since choosing any one method from the few known methods would be an obvious choice and since JP teaches the use of irradiation in parital curing (crosslinking) of polyester (B-stage) and since one would know how to adjust the dosage of irradiation in order to obtain a partially cured polyester.

(10) Response to Argument

With respect to Mitani et al (US 4,327,145),

Appellant asserts that the inclusion of isocyanate carries with it a certain health hazard, and thus that it is excluded in the instant invention. But, the instant claim 26 recites various additives, and thus, appellant's assertion that said isocyanate is excluded (even thought other additives are included in the instant invention) has little probative value. Furthermore, virtually all chemicals carry with them a certain health hazard.

General statement alone in specification does not overcome the rejection without actual showing(s). Besides, any limitation such as without thickening agent of specification is not claimed limitation. Appellant asserts that the isocyanate is undesirable due to a health concern, but the properties discussed in specification are directed to good shelf life and viscosity control and thickening (page 12), not health friendly.

With respect to Parker, Jr. (US 3,429,950),

Contrary to appellant's assertion, omission of "quinine modifier" is not needed in Parker, Jr. Again, with respect to "consisting essentially of" in claims, the recitation of "consisting essentially of" alone cannot overcome the rejection based on the art reciting "comprising". See ***In re De Lajarte***, 337 F2d 870, 143 USPQ 256 (CCPA, 1964); When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of", applicant has the burden of showing the basic and novel characteristics of his composition – i.e. a showing that the introduction of these components would materially change characteristics of applicant's invention.

With respect to Parker, Jr. (US 3,429,950) in view of Parker, Jr. (US 3,300,544), JP 54120675 A or JP 401251791 A,

Rejection is maintained for reason of record with above response under Parker, Jr. (US 3,429,950).

Again, contrary to appellant's assertion, omission of any component is not needed in Parker, Jr. (US'950), and appellant failed to show otherwise.

JPs teach B-stage polyester with additional components as long as a composition uses unsaturated polyester.

With respect to Mitani et al (US 4,327,145) or Parker, Jr. (US 3,429,950) in view of Mathur et al (US 6,063,864), Lane et al (US 5,985,785) or JP 54120675 A,

Rejection is maintained for reason of record with above response under Parker, Jr. (US 3,429,950) and Mitani et al (US 4,327,145).

Again, contrary to appellant's assertion, omission of any component is not needed in Mitani et al and Parker, Jr. (US'950), and appellant failed to show otherwise. Furthermore, the instant claims 10 and 26 recite various additives, and thus, appellant's assertion that additional component of Mitani et al and Parker, Jr. is excluded (even thought other additives are included in the instant invention) has little probative value.

Contrary to appellant's assertion, JP teaches the use of irradiation in parital curing (crosslinking) of polyester to B-stage in abstract. Furthermore, JP is recited to show the art well known electron beam source, not for a composition. Even permitting the presence of crosslinking agent of JP in Mitani et al and Parker, Jr. (US'950), it still would be obvious since the recited "consisting essentially of" does not exclude said crosslinking agent.

Lane et al teach that one can adjust dosage conditions at bottom of col. 8.

Mitani et al and Parker, Jr. (US'950), **teach partially crosslinked B-stage polyesters,** and thus use of well known electron beam sources of secondary references in partial curing of the composition (or further curing thereof) taught by Mitani et al or Parker, Jr. would be a *prima facie* obviousness since one would know how to adjust the dosage of irradiation in order to obtain a partially cured polyester.

Thus, the instant rejection would meet all of the instant composition and method claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tae H Yoon/ Tae H Yoon,

Primary Examiner, AU 1796

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